



06 MAR 2006

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Philip S. Johnson
JOHNSON & JOHNSON
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

In re Application of: :
PEETERS, et al : DECISION
U.S. Application No.: 10/533,054 :
PCT No.: PCT/EP2003/011792 :
International Filing Date: 23 October 2003 :
Priority Date: 31 October 2002 :
Attorney's Docket No.: PRD-2009-USPCT1 :
For: CRH RESPONSIVE GENES IN CNS :

This decision is issued in response to the "Response To Notification Of Missing Requirements" filed 19 December 2005, treated in part herein as a petition to confirm the filing of an acceptable declaration under 37 CFR 1.497. No petition fee is required.

BACKGROUND

On 23 October 2003, applicants filed international application PCT/EP2003/011792. The application claimed a priority date of 31 October 2002 and designated the United States. Subsequent to the filing of the international application, pursuant to PCT Rule 26ter, applicants filed therein a declaration of inventorship under PCT Rule 4.17(iv). This declaration was executed by each of the six inventors; however, the declaration did not specifically identify the international application to which it was directed, that is, PCT/EP2003/011792.

On 13 May 2004, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 April 2005.

On 27 April 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a copy of the declaration filed in the international application.

On 27 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that the declaration filed by applicants was defective for failure to properly identify the application to which it was directed. The Notification required submission of an oath or declaration acceptable under 37 CFR 1.497, as well as the surcharge for filing the oath or declaration later than thirty months after the priority date and sequence listing materials.

On 19 December 2005, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) that included the required sequence listing materials. The submission was not, however, accompanied by a new oath or declaration. Instead, applicant argued that the previously filed declaration was acceptable under 37 CFR 1.497. This argument is treated herein as a petition under 37 CFR 1.181 for acceptance of the previously filed declaration.

DISCUSSION

The instructions to the Rule 4.17(iv) declaration state: “[w]here the declaration was not included in the request, but is furnished later, the PCT application number MUST be indicated within the text of Box No. VIII (iv).” Consistent with this instruction, the text of the Rule 4.17(iv) declaration includes a line that expressly requires entry of the PCT international application number “if furnishing the declaration pursuant to Rule 26ter.”

Here, the executed Rule 4.17(iv) declaration was not filed with the original international application materials. Accordingly, the declaration was required to include the PCT application number for the application to which it was directed, that is, PCT/EP2003/011792. Because the declaration does not include this PCT application number, the declaration is defective for failure to properly identify the specification to which it was directed.

Applicants argue that the declaration is adequate because “[t]he specification to which the Oath/Declaration is directed, i.e., PCT/EP02/12274, is set forth at page 3/7 of the Oath/Declaration.” However, PCT/EP02/12274 is a priority application cited in the relevant international application, not the international application for which a declaration is required here (i.e., PCT/EP2003/011792).

Based on the above, and as set forth in the Notification Of Missing Requirements mailed 27 September 2005, the declaration filed herein is defective for failure to properly identify the application to which it was directed.

Pursuant to the authorization contained in the 19 December 2005 submission, Deposit Account No. 10-0750 will be charged the \$130 surcharge for failure to file an acceptable declaration prior to the expiration of thirty months from the priority date.

CONCLUSION

Applicants' petition for acceptance of the previously filed declaration is **DISMISSED** without prejudice.

The declaration filed by applicants during the international phase and resubmitted herein is not acceptable under 37 CFR 1.497 in that the declaration does not properly identify the specification to which it was directed.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of A Defective Response (Form PCT/DO/EO/916) requiring submission of an oath or declaration acceptable under 37 CFR 1.497.

RR

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459